

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KONSTANZE SAATHOFF and ACHIM LUBBERING

Appeal No. 2003-1399
Application No. 09/554,343

HEARD: JANUARY 6, 2004

MAILED

JAN 30 2004

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before COHEN, FRANKFORT, and PATE, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 18, all of the claims in the application.

Appellants' invention relates to a motor driven wrench having a driving motor and a head having an output tool shaft for coupling to a driving tool. A basic understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which appears in the APPENDIX to the main brief (Paper No. 16).

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The following rejections are before us for review.

Claims 1 through 18 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon a specification which lacks enablement.

Claims 1 through 18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 17), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 16 and 20).

OPINION

In reaching our conclusion on the enablement and indefiniteness issues raised in this appeal, this panel of the board has carefully considered appellants' specification,¹

¹ The specification (page 3) discusses a known manually operated torque wrench to which an air motor is attached. Additionally, Grabovac (U.S. Pat. No. 3,939,924), of record in the application teaches a power torque wrench combination. These
(continued...)

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drawings,² and claims,³ and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Enablement

We do not sustain the rejection of claims 1 through 18 under 35 U.S.C. § 112, first paragraph, as being based upon a specification which lacks enablement.

The test regarding enablement is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. See In re Wands, 858 F.2d 731, 737, 8 USPQ2d

¹(...continued)
prior art teachings are worthy of further review by the examiner relative to the claimed subject matter.

² While not at issue in this appeal, as recognized by appellants (reply brief, page 6), the examiner's concern as to the drawings is sound (answer, page 5). We note that the lowermost horizontal line in Fig. 1 is not complete. Further, considering the section line in Fig. 1, Fig. 2 is incomplete.

³ It appears that "rod-shaped" on line 5 of claim 16 should be --tubular-- for consistency with its antecedent basis on line 2 of the claim.

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1400,, 1404 (Fed. Cir. 1988) and In re Scarbrough, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974). The experimentation required, in addition to not being undue, must not require ingenuity beyond that expected of one of ordinary skill in the art. See In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 218 (CCPA 1976).

At the outset, it is worthy of noting that we fully appreciate the difficulty encountered by the examiner in reviewing the present specification and drawings, each of which is not a model of clarity. Nevertheless, as explained below, we are of the view that the disclosure before us is sufficiently complete such that one of ordinary skill in the art would be able to make and use the claimed mechanical invention without undue experimentation. As to features of the motor-driven manual wrench, such as the articulated joint, the articulated body, the adapter, and the spring, we understand from the specification and appellants' presentation to this panel of the Board that these features are known attributes of manual torque wrenches. We also recognize, as pointed out by appellants, that the motorized portion of the claimed wrench is also a known entity in the art.

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Thus, the invention, as reasonably understood from the specification and specifically argued before us on appeal by appellants, addresses the combination of two known wrenches.

Considering the showing in Fig. 1, in particular, of the interface between the two wrenches at the common output shaft 4, it is our view that one having ordinary skill in the wrench art would have been quite capable of combining two known wrenches to thus make the claimed motor-driven manual wrench without having to become engaged in any undue experimentation. As to the use of the wrench (specification, page 8), it is apparent to us that one skilled in this art would comprehend that its grip permits operation of the drive motor for the powered driving of the output shaft, as well as providing for the manual manipulation of the entire wrench to further torque the output shaft as typically done using a purely manually operated wrench. It is for the above reasons that we view the claimed subject matter as being based upon an enabling disclosure and, accordingly, we cannot sustain the rejection based upon 35 U.S.C. § 112, first paragraph.

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Indefiniteness

We sustain the rejection of claims 6 and 14 under 35 U.S.C. § 112, second paragraph, as being indefinite, but not the rejection of claims 1 through 5, 7 through 13, and 15 through 18.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

We turn now to the language of concern to the examiner as being indefinite.

We do not consider the recitation "[m]otor-driven manual wrench" in claim 1 to be contradictory (indefinite in meaning), as viewed by the examiner. From our perspective, one skilled in the wrench art, reading the recitation at issue in light of the underlying specification, would comprehend the language to denote a wrench that provides for both motor driven and manual operation.

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As to the language of lines 4 through 6 of claim 1, once again it is our opinion that one skilled in the art, cognizant of the acknowledged known motor driven and manual driven wrenches being combined in the present invention, would understand the interrelationships being claimed.

According to the examiner, claims 2, 3, 7 through 12, and 14 through 16 are not clearly supported by the specification and drawings. However, in this indefiniteness rejection, the examiner has not stated that the recitations in these claims are indefinite. As an aside, it appears to us that the content of these claims appeared in the original claims as filed, i.e., the content is supported by the original disclosure.

As to the examiner's view that lines 3 through 7 of claim 6 are not understandable in light of the specification and drawings, we agree. For example, the reference to "a shaft" (last line) is not clearly understood since parent claim 1 already sets forth an "output tool shaft". Thus, claim 6 is indefinite in meaning.

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We also share the examiner's point of view that the recitation in claim 14 of "a flat output element" is not understandable. Neither appellants' underlying disclosure (specification, page 10) nor the argument advanced on appeal (brief, page 12) offers any guidance whatsoever as to a meaning that can be attributed to a "flat output element". Thus, the language at issue renders claim 14 indefinite.

In summary, this panel of the board has not sustained the rejection under 35 U.S.C. § 112, first paragraph, and the rejection of claims 1 through 5, 7 through 13, and 15 through 18 under 35 U.S.C. § 112, second paragraph, but has sustained the second paragraph rejection of claims 6 and 14.

The decision of the examiner is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IRWIN CHARLES COHEN
Administrative Patent Judge

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

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